

REMARKS

By this Amendment, claims 2 and 17 have been amended. Claims 1-24 are pending. Reconsideration of the October 22, 2003, Office Action is respectfully requested.

1. Rejection of Claims 2, 3 and 5 Under 35 U.S.C. §112, ¶2

Claims 2, 3, 5 and 17 stand rejected under 35 U.S.C. §112, ¶2.

Claims 2 and 17 have been amended to address the points stated in the Office Action. Claim 2, as amended, recites that "the part made of thermoplastic material positioned in the concave space of the rigid element presents a conjugate profile to the concave space defined by the profile of the rigid element" (emphasis added). Support for this amendment can be found at least at page 7, lines 7-10, of the specification. This amendment does not narrow the scope of claim 2. Applicants respectfully submit that one having ordinary skill in the art would understand the meaning of claim 2 in light of the specification and drawings.

Claim 17 has been amended to be consistent with the subject matter recited in claim 16 and now recites "The fluid-transfer device as claimed in claim 16 ... and oils" (emphasis added).

Applicants respectfully submit that claims 2 and 17 are in compliance with the provisions of 35 U.S.C. §112, ¶2. Withdrawal of the rejection is therefore respectfully requested.

2. Rejections Under 35 U.S.C. §102

A. Claims 1, 2, 4, 5, 7, 9, 10, 12, 15, 18 and 20-24 stand rejected under 35 U.S.C. §102(b) over U.S. Patent No. 5,456,957 to Jackson et al. ("Jackson"). The rejection is respectfully traversed.

Claim 1 recites “an article comprising a part comprising a rigid metal or thermoplastic element of elongate shape, at least one part of which has a cross section which has a profile defining a concave space, and comprising at least one part made of thermoplastic material associated with the rigid element and positioned in the concave space of the rigid element, wherein the part made of thermoplastic material is in contact on at least two lines which are continuous in the longitudinal direction, and in that the part made of thermoplastic material has a cross section comprising at least one hollow” (emphasis added). That is, the claimed article comprises a rigid element and “at least one part made of thermoplastic material associated with the rigid element and positioned in the concave space of the rigid element.” Jackson fails to anticipate the claimed article.

Jackson discloses automotive molding trim members and methods of molding the trim members. FIGs. 2 and 3 of Jackson depict a molding trim member 10 including an exterior layer 16 and a molded backing member 18. Jackson discloses that “[t]he backing member 18 provides structural integrity to the trim member while the exterior layer 16 provides a show surface for the trim member” (column 3, lines 10-22), that the outer layer 16 is made from a sheet that is flexible, elastic and resilient, which permits it to stretch in the mold (column 3, lines 23-30), and that “[o]nce the backing member is molded, the sheet is merely an outer layer 16 that provides a show surface 20 to the trim member” (column 3, lines 62-64). Accordingly, Jackson clearly discloses that the outer layer 16 needs to be flexible for molding purposes and thus fails to disclose or suggest the recited “part comprising a rigid metal or thermoplastic element.” As Jackson fails to disclose each and every feature recited in claim 1, claim 1 is not anticipated by Jackson.

Dependent claims 2, 4, 5, 7, 9, 10, 12, 15 and 18 also are not anticipated by Jackson for at least the same reasons that claim 1 is not anticipated.

Independent claim 20 recites "a method for fabricating an article comprising at least one rigid metal or thermoplastic element a cross section of which has at least one part defining a concave space and comprising at least one element made of a molded thermoplastic material" (emphasis added), which comprises, inter alia, "a) arranging, in an injection mold of chosen shape, a preformed rigid metal or thermoplastic element one cross section of which has at least one part defining a concave space" (emphasis added) and "b) injecting molten thermoplastic material into the mold." For reasons stated above, Jackson fails to disclose the claimed method of making "an article comprising at least one rigid metal or thermoplastic element a cross section of which has at least one part defining a concave space and comprising at least one element made of a molded thermoplastic material" (emphasis added), including at least the step of "a) arranging, in an injection mold of chosen shape, a preformed rigid metal or thermoplastic element one cross section of which has at least one part defining a concave space" (emphasis added). As Jackson fails to disclose each and every feature recited in claim 20, claim 20 also is not anticipated by Jackson.

Dependent claim 23 also is not anticipated by Jackson for at least the same reasons that claim 20 is not anticipated.

Independent claim 21 recites "a method for fabricating an article comprising at least one rigid metal or thermoplastic element a cross section of which has at least one part defining a concave space and comprising at least one element made of a molded thermoplastic material" (emphasis added), which comprises, inter alia, "a)

arranging, in an injection mold of chosen shape, a rigid metal or thermoplastic element that is to be preformed, b) preforming the rigid element by pressing or by hot forming in the mold, the preform having a cross section which has at least one part defining a concave space, c) injecting molten thermoplastic material into the mold" (Emphasis added.) For reasons stated above, Jackson fails to disclose each and every feature of the method recited in claim 21. Therefore, claim 21 also is not anticipated by Jackson.

Dependent claim 24 also is not anticipated by Jackson for at least the same reasons that claim 21 is not anticipated.

Withdrawal of the rejection is therefore respectfully requested.

B. Claims 1, 2, 4, 6-10, 13-15, 18 and 22 stand rejected under 35 U.S.C. §102(b) over U.S. Patent No. 5,190,803 to Goldbach et al. ("Goldbach"). The rejection is respectfully traversed.

Goldbach discloses lightweight components including a shell and reinforcing ribs connected to the shell. The shell 1 shown in FIG. 1 of Goldbach includes side walls 8, 9, V-shaped reinforcing ribs 3 and connecting webs 10. Goldbach fails to disclose each and every feature recited in claim 1. Namely, Goldbach does not disclose "an article comprising a part comprising a rigid metal or thermoplastic element of elongate shape, at least one part of which has a cross section which has a profile defining a concave space, and comprising at least one part made of thermoplastic material associated with the rigid element and positioned in the concave space of the rigid element, wherein the part made of thermoplastic material is in contact on at least two lines which are continuous in the longitudinal direction,

and in that the part made of thermoplastic material has a cross section comprising at least one hollow" (emphasis added).

Goldbach fails to disclose the feature of a "part made of thermoplastic material is in contact on at least two lines which are continuous in the longitudinal direction" (emphasis added). As explained at page 6, lines 11-18, of the specification, the language "contact along at least two lines" means "that, for any cross section, the rigid element and the part made of thermoplastic material are in contact at least at two points on the profile defining the concave space." Goldbach does not disclose the claimed article comprising a rigid element and a part made of thermoplastic material which are "in contact on at least two lines which are continuous in the longitudinal direction." See, e.g., the shell shown in FIG. 1 of Goldbach.

Goldbach further fails to disclose a part made of thermoplastic material that "has a cross section comprising at least one hollow," as recited in claim 1. As explained at page 7, first paragraph, of the specification, "a cross section comprising at least one hollow" means a cross section that has at least one space which is completely surrounded by a thermoplastic material. Goldbach does not disclose such feature. As Goldbach fails to disclose each and every feature recited in claim 1, claim 1 is not anticipated by Goldbach.

Dependent claims 4, 6-10, 13-15, 18 and 22 also are not anticipated by Goldbach for at least the same reasons that claim 1 is not anticipated.

Withdrawal of the rejection is respectfully requested.

3. Rejections Under 35 U.S.C. §103

A. Claims 16, 17 and 19 stand rejected under 35 U.S.C. §103(a) over Jackson. The rejection is respectfully traversed.

Claims 16, 17 and 19 depend from claim 1. For reasons stated above, Jackson fails to disclose, nor does Jackson suggest, the article recited in claim 1. Accordingly, dependent claims 16, 17 and 19 also are patentable over Jackson for at least the same reasons that claim 1 is patentable.

Withdrawal of the rejection is respectfully requested.

B. Claims 16, 17 and 19 stand rejected under 35 U.S.C. §103(a) over Goldbach. The rejection is respectfully traversed.

Claims 16, 17 and 19 depend from claim 1. For reasons stated above, Goldbach fails to disclose, nor does Goldbach suggest, the article recited in claim 1. Accordingly, dependent claims 16, 17 and 19 also are patentable over Goldbach for at least the same reasons that claim 1 is patentable.

Withdrawal of the rejection is respectfully requested.

C. Claim 11 stands rejected under 35 U.S.C. §103(a) over Jackson in view of Goldbach. The reasons for the rejection are stated on page 5 of the Official Action. The rejection is respectfully traversed.

Claim 11 depends from claim 1. Goldbach fails to cure the deficiencies of Jackson regarding the article recited in claim 1. As explained above, Jackson discloses that the outer layer 16 needs to be flexible for molding purposes. Thus, Jackson teaches away from modifying the disclosed molding trim member to include a "part comprising a rigid metal or thermoplastic element," as recited in claim 1. Moreover, modifying Jackson's molding trim member to include a "part comprising a

"rigid metal or thermoplastic element" would change the principle of operation of Jackson's molding trim member, and would appear to make the outer layer unsuitable for its intended purpose. For at least these reasons, Jackson and Goldbach fail to provide the required motivation to modify Jackson's molding trim member to achieve the article recited in claim 1. See MPEP §2143.02, page 2100-127 (Feb. 2003 revision). Thus, claim 11 is patentable over Jackson and Goldbach for at least the same reasons as those for claim 1.

Withdrawal of the rejection is respectfully requested.

For the foregoing reasons, withdrawal of the rejections and prompt allowance of the application are respectfully requested.

Respectfully submitted,

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